

REMARKS

Claims 1-10 and 27-54 are pending in the application. In support of the rejection, page 7 of the Office Action states that prior to the current amendment, “the word ‘same’ nowhere appears in any of the claims.” Office Action (p. 7). Claims 1, 27, 39, 43 and 47 are currently amended to recite *inter alia* “a single relatively short tubular shaft,” claims 1 and 27 are currently amended to now recite *inter alia* “a coagulation element . . .” and “a stimulation element . . . on the distal region of the same relatively short tubular shaft” and claim 47 is currently amended to now recite *inter alia* “means, having a different configuration than the means for coagulating tissue, for stimulating tissue on the distal region of the same relatively short tubular shaft.”

The amendments to the claims do not present new matter, particularly considering that that there is no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification and support for claim amendments can be supported by express, inherent or implicit disclosure. MPEP §608.01(o); MPEP §2163 (While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure). *See, e.g.*, p. 7, lines 13-24 (probe 100 includes a relatively short shaft 102); Figs. 1 and 2 (single shaft 102; coagulation electrodes 110 and stimulation electrodes 112, 114 on the distal portion 108 of the same single shaft 102). Claims 11-26 were previously canceled. Claims 7, 37 and 38 are withdrawn from consideration. Reconsideration and allowance of the application, as amended, are respectfully requested.

I. Non-Rejected Claims / Withdrawn Rejection

Applicant acknowledges that independent claim 30 is not rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,010,500 to Sherman *et al.* (hereafter “Sherman”).

Applicant also acknowledges that the rejection of claim 36 as allegedly being anticipated by Sherman under 35 U.S.C. §102(b) has been withdrawn. Office Action (p. 2).

Further, Applicant acknowledges that it is conceded that all of pending claims 1-10 and 27-54 are patentable over Sherman since they are not rejected under 35 U.S.C. §103(a).

Applicant further acknowledges that claims 2-10, 29, 31-35, 37, 38, 40, 42, 44 and 46-54 are not rejected under 35 U.S.C. §102(c) as allegedly being anticipated by U.S. Patent No. 6,889,694 to Hooven (hereafter “Hooven”).

Applicant also acknowledges it is conceded that all of pending claims 1-10 and 27-54 are patentable over Hoooven since they are not rejected under 35 U.S.C. §103(a).

Applicant also notes that piecemeal examination should be avoided as much as possible, and the Examiner ordinarily should reject each claim on all valid grounds available. MPEP §707.07(g).

II. Claims 1-6, 8-10, 27-29 and 31-35 and 37-54 Are Novel Over Sherman

Independent claims 1, 27 and 47 and respective dependent claims 2-6, 8-10, 28, 29, 31-35 and 37-54 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Sherman, no pending claim being rejected under 35 U.S.C. §103(a). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant respectfully traverses the rejection since Sherman fails to anticipate any claim of the subject application.

It is alleged in the Office Action that the “relatively short shaft” is the portion of the inner shaft 12 that extends “from a point proximal of the most proximal 32 to the distal end of 12.” Office Action (p. 2). It is further alleged in the Office Action that a ring electrode 18 is a “coagulation element” and that the radiopaque markers 38a and 38b define a “stimulation element.” Applicant respectfully submits that the rejection is moot for a number of reasons.

As noted in the Office Action, Sherman fails to disclose, teach or suggest “a single, relatively short tubular shaft defining a distal region and a proximal region” as recited in claims 1, 27 and 47. In contrast, Sherman describes a specific configuration involving two different shafts, *i.e.*, an inner shaft 12 and a separate outer shaft 14. Sherman (col. 4, lines 1-2; Fig. 1); Office Action (p. 7) (noting different inner shaft 12 and outer shaft 14 components). Thus, the alleged “admission” (Office Action, p. 7) is an explanation of why Sherman is clearly deficient relative to claims 1, 27 and 47 that recite a single shaft.

Moreover, Sherman fails to disclose, teach or suggest “a coagulation element . . . on the distal region of the relatively short tubular shaft” and “a stimulation element . . . on the distal region of the same relatively short tubular shaft . . .” as recited in claims 1 and 27 and means for stimulating tissue “on the distal region of the same relatively short tubular shaft” as recited in claim 47. As discussed above, Sherman describes a specific structural configuration that involves two different shafts. Moreover, it is alleged in the Office Action that alleged “shaft” is defined by a portion of the inner shaft 12 (Office Action, p. 2), but the Office Action fails to

reconcile the fact that electrodes 18 of the ablation section 16 are on the inner shaft 12, but the radiopaque markers 38a and 38b are on a different shaft, *i.e.*, outer shaft 14.

Nevertheless, it is alleged that the alleged stimulation elements (*i.e.*, the radiopaque markers 38a, 38b) are “on the distal end of the relative short tubular shaft (inner shaft 12).” Office Action (p. 7). However, this allegation disregards the fact that Sherman specifically describes a different configuration, *i.e.*, a two-shaft configuration in which radiopaque markers 38a, 38b are on the outer shaft 14, not the inner shaft 12. Accordingly, the Office Action allegation is contrary to Sherman and cannot support the rejection, and an allegation that the different inner and outer shafts 12, 14 are the same shaft or a single shaft is contrary to the specific “two-shaft” configuration described by Sherman and the understanding of persons skilled in the art that two separate shafts are not a single shaft.

Thus, not only does Sherman fail to disclose, teach or suggest the structural limitations recited in claims 1, 27 and 47, but Sherman specifically describes a structural configuration that is the opposite of the configurations recited in claims 1, 27 and 47. Moreover, given the particular configuration and use of these slidable or telescoping different shafts 12 and 14 and window 36, there would be no suggestion or motivation to modify Sherman to as recited in the claims since doing so would significantly alter the device described by Sherman or render it inoperable.

In view of these substantial differences, Applicant respectfully submits that Sherman does not anticipate independent claims 1, 27 and 47 under §102(b). Dependent claims 2-6, 8-10, 28, 29, 31-46 and 48-50 incorporate the elements and limitations of respective independent claims 1, 27 and 47 and, therefore, are also novel over Sherman for at least the same reasons.

Additionally, Sherman fails to disclose, teach or suggest “wherein the coagulation element and the stimulation element are carried on the same relatively short tubular shaft such that the coagulation element and the stimulation element are longitudinally fixed relative to one another” as recited in claims 39 and 43 in view of the above remarks and since Sherman describes an inner shaft 12 that is slidably movable (*i.e.* not fixed) within the outer shaft 14. Specifically, ring electrodes 18 are on one shaft (the inner shaft 12), whereas radiopaque markers 38a, 38b are on a different shaft (the outer shaft 14), which is movable relative to the inner shaft 12. Thus, Sherman describes a configuration that is the opposite of claims 39 and 43.

Sherman also fails to disclose, teach or suggest “wherein the distal portion of the relatively short tubular shaft includes a unitary outer member and the coagulation element and

the stimulation element are both carried on the unitary outer member” as recited in claims 40 and 44. Rather, as discussed above, Sherman describes two separate shafts, an inner shaft 12 that carries an electrode 18 and an outer shaft 14 that carries markers 38a and 38b. Thus, Sherman describes a configuration that is the opposite of that recited in claim 40.

Sherman also fails to disclose, teach or suggest “wherein the coagulation element and the stimulation element define respective diameters and the diameter of the coagulation element is substantially equal to the diameter of the stimulation element” as recited in claims 42 and 46. Sherman describes electrodes 18 on the inner shaft 12 as ring electrodes, but shows markers 38a and 38b as elements on the outer shaft 14 that do not surround the outer shaft 14. Sherman (Fig. 1). Moreover, the inner shaft 12, by definition, has a diameter that is smaller than the diameter of the outer shaft 14 since the inner shaft 12 slides within the outer shaft 14. Thus, the Office Action allegation contradicts the multi-shaft configuration described by Sherman and the fact that the inner and outer shafts 12, 14 must have different diameters.

In view of the above remarks and deficiencies of Sherman, Applicant respectfully requests that the rejection of claims 1-6, 8-10, 27-29 and 31-35 and 37-54 under 35 U.S.C. §102(b) be withdrawn.

III. Claims 1, 27, 28, 30, 36, 39 and 43 Are Novel Over Hooven

As noted above in section I, claims 2-10, 29, 31-35, 37, 38, 40, 42, 44 and 46-54 are not rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hooven, no pending claim being rejected under 35 U.S.C. §103(a) based on Hooven. Rather, only independent claims 1, 27 and 30 and respective dependent claims 28, 36, 39 and 43 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Hooven. MPEP §707.07(g) (piecemeal examination should be avoided). Applicant respectfully traverses the rejection.

Claims 1 and 27 have been amended to recite *inter alia* “a single, relatively short tubular shaft defining a distal region and a proximal region” and “the same relatively short tubular shaft.” The Office Action appears to allege that the fixed jaw assembly is a “relatively short shaft” as recited in the claims, but then refers to “the relatively short shaft (116 and 118).” Office Action (p. 5). The basis of the rejection is not clear - is the relatively short tubular shaft allegedly formed by only the fixed jaw assembly 116, or by a combination of different and separate fixed and movable jaw assemblies 116 and 118?

Further, it is generally alleged that “Hooven clearly shows the recited tubular shaft.” Office Action (p. 8). It is implicitly conceded that Figures 33-51 and 66 of Hooven do not

disclose, teach or suggest a relatively short shaft that is tubular. Office Action (p. 5). To support the rejection under §102(e), the Office Action relies on Figures 41-46 of Hooven. Figures 41-46 of Hooven, however, show a first jaw member 116 having an electrode 120, and a second jaw member 118 having an electrode 126. These electrodes 120, 126 are for “ablating the tissue between these electrodes.” Hooven (Figs. 41-46; col. 13, lines 1-2). Accordingly, Figures 41-46 do not disclose, teach or suggest a single, relatively short tubular shaft, a coagulation element defining a coagulation element configuration on the distal region of the relatively short tubular shaft and a stimulation element defining a stimulation element configuration on the distal region of the same relatively short tubular shaft as recited in claims 1 and 27. Further, Figures 41-46 show tissue ablation electrodes 120, 126 having the same configuration, contrary to claims 1 and 27, which recite the stimulation element configuration being different than the coagulation element configuration. Thus, it is not clear how the component configurations shown in Figures 41-46 are applied to support an anticipation rejection of the claims since the jaw members 116, 118 shown in Figures 41-46 only have electrodes 120, 126 for tissue ablation and having the same configuration, whereas Figure 66 shows jaw members 116, 118 having different (non-tubular) configurations and different components having different functionality.

Moreover, Hooven fails to disclose, teach or suggest a surgical probe including “a relatively short shaft defining a distal region and a proximal region, a handle associated with the proximal region of the relative short shaft” as recited in claim 30. For example, a proximal end of the fixed jaw member 116 is associated with a fixed member 134, not a handle. Hooven (Figs. 33-37 and 69; col. 11, lines 15 - 67).

Accordingly, Applicant respectfully submits that independent claims 1, 27 and 30 are novel over Hooven. Dependent claims 28, 36, 39 and 43 incorporate the elements and limitations of respective independent claims 1 and 27 and, therefore, are also believed novel over Hooven for at least these same reasons.

In view of the above remarks and deficiencies of Hooven, Applicant respectfully requests that the rejection of claims 1, 27, 28, 30, 36, 39 and 43 under 35 U.S.C. §102(e) be withdrawn.

CONCLUSION

Applicant respectfully requests entry of this Amendment, and submits that doing so will place the application in condition for allowance in view of the forgoing amendments and

remarks. If there are any remaining issues that can be resolved by telephone, Applicant invites the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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